

REMARKS

This amendment is responsive to the Office Action dated February 23, 2005. Applicant has amended claims 5, 15 and 16 and added new claims 21-27. No new matter has been introduced by new claims 21-27. Claims 1-27 are pending.

Claim Rejection Under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 15 and 16 under 35 U.S.C. 102(e) as being anticipated by Messenger et al. (USPN 6,791,785). Applicant respectfully traverses the rejection to the extent such rejection may be considered applicable to the amended claims. Messenger et al. fails to disclose each and every feature of the claimed invention, as required by 35 U.S.C. 102(e), and provides no teaching that would have suggested the desirability of modification to include such features.

For example, Messenger et al. fails to teach or suggest determining seek profile compensation information corresponding to a plurality of initial data storage device operating temperatures sufficient to maintain the data storage device operating temperature below an operating temperature threshold, as recited by Applicant's claim 15, as amended. This amended claim language is similar to language of claim 1 indicated as allowable in the reasons for allowability given in the Office Action dated February 23, 2005.

In order to support an anticipation rejection under 35 U.S.C. 102(e), it is well established that a prior art reference must disclose each and every element of a claim. This well-known rule of law is commonly referred to as the "all-elements rule." If a prior art reference fails to disclose any element of a claim, then rejection under 35 U.S.C. 102(e) is improper.

Messenger et al. fails to disclose each and every limitation set forth in independent claim 15. For at least these reasons, withdrawal of the rejection of claims 15 and 16 under 35 U.S.C. 102(e) is respectfully requested.

New Claims:

Applicant has added claims 21-27 to the pending application. New claim 21 depends from allowed claim 19 and is therefore allowable for the same reasons that claim 19 is allowable. New independent claim 22 recites a device comprising a controller that controller that determines a seek profile compensation value for each of a plurality of initial data storage device operating temperatures sufficient to maintain the data storage device operating temperature below the operating temperature threshold. New independent claim 22 and dependent claims 23-27 are thus believed to be allowable as indicated by the Examiner in the reasons for allowability as given in the Office Action dated February 23, 2005.

Allowable Subject Matter

Applicant appreciates the allowance of claims 1-14 and 19-20. Claims 17-18 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. As discussed above, claims 15 and 16 are allowable over the prior art of record. No amendment of claims 17-18 is therefore required. Consequently, Applicant submits that all pending claims are in condition for allowance.

CONCLUSION

All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 50-1778. The Examiner is invited to telephone the below-signed attorney to discuss this application.

Date:

June 23, 2005
SHUMAKER & SIEFFERT, P.A.
8425 Seasons Parkway, Suite 105
St. Paul, Minnesota 55125
Telephone: 651.735.1100
Facsimile: 651.735.1102

By:

Kari H. Bartingale
Name: Kari H. Bartingale
Reg. No.: 35,183